REMARKS

Status of the Claims

Claims 1-11 and 13-26 remain pending in the application, Claim 23 having been amended in order to more clearly define the present invention, and Claim 12 having been previously cancelled.

Claims Rejected Under 35 U.S.C. § 103(a)

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1, 7, 11, and 23. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. In any event, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

Discussion of the Rejection of Claims 1 - 5

The Examiner has rejected Claims 1-5 as being unpatentable under 35 U.S.C. § 103 over Microsoft Outlook 2000 (version 9.0.0.4527; copyright 1999, hereinafter referred to as "Outlook") in view of Thompson et al. (U.S. Patent Publication No 2001/0003183, hereinafter referred to as "Thompson"). The Examiner asserts that "Outlook does not expressly teach unique identifier, but Thompson teaches that a name can be a unique identifier that is associated with a string (paragraph 27)." The Examiner concludes that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Outlook to include a Name as a unique identifier as taught by Thompson, providing the benefit of formulating information requests in complex query languages (paragraph 16)." Applicants respectfully disagree with the assertion and with the conclusion of the Examiner for the reasons discussed below.

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Discussion of the Rejection of Independent Claim 1

Significant differences exist between the cited art and applicants' recitation of the first step of independent Claim 1, because the cited art does not teach or suggest both a string and an identifier that is unique.

Specifically, applicants' first step recites "identifying a string having a unique identifier associated with the string." Thus, there are at least three components recited by the first step:

(1) a *string* is identified;

(2) the string has an *identifier* associated with it; and

(3) the identifier is *unique*.

Discussion of the Second and Third Component of the First Step

Under the section entitled "Response to Arguments," the Examiner notes that if the user entered "sain, g" in the search field of Outlook, it would return the unique name of "sain, Gautam" which is the unique identifier for that Name. Accordingly, applicants understand the Examiner to be asserting that the second and third claim components are disclosed by Outlook. In other words, for the example given by the Examiner, "sain, g" is a unique identifier for the name "sain, Gautam."

Discussion of the First Component of Applicants' First Step

Even if the Examiner's assertion were, *arguendo*, correct, the Examiner should note that applicants' recited *unique identifier* is separate from applicants' first claim component recitation that requires a *string* to be identified. Therefore, it is not clear to applicants what element of the cited art the Examiner believes to be equivalent to applicants' recitation of a *string* that is identified.

It appears that the Examiner is thus asserting that "sain, g" is equivalent to applicants' recited *string*. If so, the Examiner must also be asserting the prior art teaches that: (1) a string (such as "sain, g") is identified; and (2), the string (i.e., "sain, g") has a *unique* identifier (i.e., "sain, Gautam") associated with it. However, there is a problem with this assertion about the teaching of the prior art, because the Examiner has indicated that "sain, g" is a unique identifier for the name "sain, Gautam." Applicants do not understand how the "sain, g" can be both a string and a unique identifier. Also, "sain, Gautam" is a name (i.e., it must correspond to the information that is associated with the unique identifier and cannot be the unique identifier).

Furthermore, "sain, g" is clearly not a *unique identifier* associated with the name "sain, Gautam." At most, "sain, g" is only a string and cannot be a *unique identifier* associated with the

name "sain, Gautam." Instead, it could only be an identifier associated with a number of names, because, as is apparent from the list of names shown in page 1 of Outlook, there could easily be more than one name associated with the string (or identifier ?) "sain, g." For example, the list of names returned in response to the entry of "sain, g" could include "Sain, George." Therefore, when someone types in a string "sain, g," there is not a unique identifier or name associated with it, since it could be associated with name "Sain, George" equally as well as the name "Sain, Gautam." Thus, Outlook fails to disclose a string that is associated with a unique identifier associated with information, such as a name.

Note that to establish *prima facie* obviousness of a claim, all of the claim recitation must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (MPEP 2143.03). Accordingly, since Outlook in view of Thompson neither teaches nor suggests all of the recitation of independent Claim 1, the rejection of independent Claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claims 2-5 are patentable for at least the reasons discussed above in regard to independent Claim 1. Accordingly, the rejection of dependent Claims 2-5 under 35 U.S.C. § 103(a) should be withdrawn.

Discussion of the Rejection of Independent Claim 7

Significant differences exist between the cited art and applicants' recitation included in the second step of independent Claim 7, because the cited art does not teach or suggest determining that an identity of a *user* is relevant.

Specifically, applicants' second step recites "determining that an identity of a user is relevant to the selected reference material." Thus, there are at least two claim components recited by this second step:

(1) determining that an identity is relevant to the selected reference material; and

(2) the identity is that of a user.

However, the Examiner has rejected Claims 7-10 as being unpatentable over Gehani et al. (U.S. Patent No 5,946,687, hereinafter referred to as "Gehani"). Under the section entitled "Response to Arguments," in response to applicants' arguments from the previous Office Action Response that Gehani does not teach or suggest the second and last steps of Claim 7, the Examiner

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has asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Gehani's teachings of maps and yellow page information as reference material, providing the benefit of a personal information manager known by an address book, including a name and an address that provides a user with maps and directions. (Gehani, column 4, lines 22-45.) In addition, the Examiner has asserted that the second step of applicants' claim is disclosed by Gehani, since Gehani discloses that a name is relevant to geographical information in the personal information manager, citing column 3, lines 20-25. Also, the Examiner asserts that the last step of applicants' claim is taught by Gehani since geographical information is presented with MAP, weather or Yellow Pages into an appropriate request format, citing column 4, lines 37-45, line 21.

Discussion of the Claim Components of the Second Step

It appears the Examiner is asserting that Gehani teaches the equivalent of applicants' claim recitation in the second step, of "determining an identity that is relevant to the selected reference material," because he asserts that the selected reference material is the personal information manager, and a name is equivalent to an identity. The citation is provided below, with the portion cited by the Examiner in support of his argument underlined:

> FIG. 1 illustrates portions of a computer system 10 in accordance with an exemplary embodiment of the invention. The system 10 includes a "geo-enabled" personal information manager (PIM) 12 and a PIM database 14. The PIM 12 <u>is a computer software program which runs on a computer of the system 10 and allows a user 16 to maintain and track information such as names, addresses and telephone numbers of personal and business contacts. The PIM 12 may be implemented as, for example, an address book program, a contact manager program, a record keeper program,</u> an organizer program, or a scheduler program. The PIM 12 may be a stand-alone application program, or a program embedded in a larger application program such as a web browser or document processing program. Like a conventional PIM, the PIM 12 may store information such as name, title, company name, company address, home address, telephone and facsimile numbers, e-mail address, scheduled activities, and notes for a number of personal or business contacts, businesses and the like. The PIM 12 stores this information as a set of records in the PIM database 14, which may be a hard disk of a computer running the PIM program, or any other suitable memory. (Gehani, column 3, lines 16-37.)

Based on this citation, it appears that the personal information manager enables a user to maintain and track information related to personal and business contacts. But it does not appear that Gehani teaches or suggests applicants' second claim recitation component that the identity is that of a *user*. The teaching of the identity (or names) of a user's friends or co-workers (i.e., the personal and

business contacts) as disclosed by Gehani is not the same as teaching that the identity of the user is relevant to the selected reference material, particularly in the context of applicants' recited claim language.

Discussion of the Last Step of Claim 7

The last step in applicants' Claim 7 recites "providing the selected reference material in a manner that is relevant to the identified user." The portions of Gehani cited by the Examiner in support of his argument that this step is disclosed by the reference are underlined in the following text:

> FIG. 2 shows a network-based implementation of the system 10 of FIG. 1. In this implementation, a client 30 communicates with a server 32 over a network 34. The client 30 and server 32 are computers associated with the system 10. The PIM 12 of FIG. 1 is running in an application layer of the client 30, while the server 32 corresponds to the GeoServer 20. The client 30 includes a processor 36 and a memory 38, and the server 32 includes a processor 40 and a memory 42. The memories 38 and 42 may include electronic memory, disk-based memory or both, as well as other types of memory. The PIM 12 responds to a user-entered request for geographic information regarding a particular location identifier by generating a corresponding Hypertext Transfer Protocol (HTTP) request. A TCP/IP connection is then established between the client 30 and server 32 to process the request. The geographic information request may be received in an application layer of the server 32, and responded to by a file transfer system or other program run by processor 40. The requested geographic information may be designated in part by a uniform resource locator (URL) which includes a domain name identifying the server 32. In alternative embodiments, the request may be generated by another program running on the client 30, such as a browser program, which receives a location identifier and other request-related information <u>from the PIM 12 and formats it into an appropriate request</u> (Gehani, column 3, line 63-column 4, line 21).

> <u>The display 50 also includes a number of buttons 60, 62, 64 and 66 which correspond to different types of geographic information which the user can request from the GeoServer 20 within the display 50. The buttons in this embodiment include MAP button 60, DIRECTIONS (DIR) button 62, WEATHER (WTR) button 64 and YELLOW PAGES (YP) button 66. The user enters a given request for geographic information by pointing to and clicking the corresponding button using a mouse or other similar user interface device.</u> In this embodiment, a request for geographic information is based on an address A of the contact in field 52. The address A may be a complete business or home address, or a portion thereof such as a state, city, town or zip code. The PIM 12 incorporates this address or a suitable portion or representation thereof into a geographic information request which is sent to the GeoServer 20 in the manner previously described. It should be noted that although in this embodiment each button 60, 62, 64 and 66 is used to generate a different type of request to a single

GeoServer 20, in other embodiments each button may be used to generate a request to a different server. Other possible implementations of the display could utilize a separate set of buttons for each of a number of different displayed records or record identifiers, or alternatively a single set of buttons which would apply to a highlighted record identifier in a set of displayed record identifiers (Gehani, column 4, lines 37-62).

It appears that Gehani teaches that the user may enter the name of a contact, such as the name of a person or business or any other identifier of a record and may retrieve a record stored for a given contact name such as a title, company name, etc. The user may also retrieve geographic information based on an address. However, applicants do not see how the above citations from Gehani teach or suggest that any of this information is retrieved in a manner that is relevant to the identified user. Information that is retrieved appears to be relevant to the contact name entered into the PIM, which is not the name of the user of the PIM. The reference thus does not teach or suggest that the information retrieved in a record must be provided in a manner relevant to an identified user. Instead, the reference teaches that the information might be provided in a manner relevant to the name of a contact.

To establish *prima facie* obviousness of a claimed invention, all the claim recitation must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (MPEP 2143.03). Accordingly, the rejection of independent Claim 7 under 35 U.S.C. § 103(a) should be withdrawn because Gehani fails to teach or suggest all of the claim recitation components of independent Claim 7.

Because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claims 8-10 are patentable for at least the reasons discussed above in regard to independent Claim 7. Accordingly, the rejection of dependent Claims 8-10 under 35 U.S.C. § 103(a) should be withdrawn.

Discussion of the Rejection of Independent Claim 11

Independent Claim 11 is directed towards a system for integrating reference material into an electronic document. The Examiner has again rejected Claims 11, 13, 14, 18, 19, 21, and 22 as being unpatentable over Outlook in view of Gehani. With respect to Claim 11, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Outlook to include maps and yellow pages information as reference material based on user requesting

info on a location as taught by Gehani, providing the benefit of a personal information manager known by an address book including names and addresses that provides a user with maps AND directions.

However, in a manner similar to independent Claim 1, Claim 11 recites a string having a *unique* identifier associated with the string. Therefore, for much the same reasons noted above traversing the rejection of independent Claim 1, the cited art does not teach or suggest a string and a unique identifier associated with the string. Accordingly, the rejection of independent Claim 11 under 35 U.S.C. § 103(a) should be withdrawn, because Outlook in view of Gehani neither teaches nor suggests all of the claim recitation of independent Claim 11.

Because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claims 13, 14, 18, 19, 21, and 22 are patentable for at least the reasons discussed above in regard to independent Claim 11. Accordingly, the rejection of dependent Claims 13, 14, 18, 19, 21, and 22 under 35 U.S.C. § 103(a) should be withdrawn.

Discussion of the Rejection of Independent Claim 23

The Examiner has rejected Claims 23-24 as being unpatentable over Thompson in view of Concepts' Wordworks (Non Patent Literature, copyright May 1997, hereinafter known as "Wordworks"). The Examiner has asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thompson to include a definition of a word from the dictionary, where the definition is displayed in the user interface as taught by Wordworks, providing the benefit of a simple but effective tool useful to serious users who produce a lot of text.

More specifically, under the section entitled "Response to Arguments," the Examiner acknowledged applicants' earlier submitted argument that Thompson does not teach or suggest displaying a dictionary interface "in response to a selection of a dictionary control" or that the "dictionary control is provided by the application program." However, the Examiner asserts that Thompson does teach in paragraph 62 that queriable keyword dictionary is accessible from the user's computer or the Internet. Thus, the Examiner concludes it would be "obvious to combine the dictionary as described in the Wordworks reference which is a dictionary that works with all types of software applications." Applicants respectfully disagree for the reasons noted below.

Applicants have amended the first step of independent Claim 23 to recite "in response to a selection of a dictionary control provided *in a user interface* of the application program, displaying a dictionary interface on a display device." Thus, applicants have clarified that a dictionary control is provided in a user interface (accessible, for example, "via a control on a menu or toolbar," see applicants' specification, page 11, line 15), and that then, a separate interface (i.e., a *dictionary* interface) is displayed on a display device. In contrast, it appears that in Thompson, a user continually works in a single user interface window of query, keyword search program, as shown in Tables I through Tables IV of Thompson. For example, Table I is shown as blank until a user types the word "cold" into it, as shown in Table II, and then enters this keyword. This screen is updated to provide three concepts related to "cold," as shown in Table III. The user may select one of these concepts, causing a screen that includes a detailed description of the selected concept to be returned (Thompson, paragraph 0067). Thus, all information obtained in Thompson is enabled through a single graphical user interface screen. It does not appear that Thompson teaches or suggests a dictionary control that is provided in a user interface of an application program (which, as will be evident from the context, is unrelated to the concept searching interface), or that any such dictionary control accessed in an application program can be used to display a dictionary interface on a display device. Furthermore, there is no reason evident in either Wordworks or Thompson that would lead one of ordinary skill in the art to modify and or combined the references to make the combination suggested by the Examiner. Accordingly, the rejection of independent Claim 23 under 35 U.S.C. § 103(a) should be withdrawn.

Because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claim 24 is patentable for at least the reasons discussed above in regard to independent Claim 23. Accordingly, the rejection of dependent Claim 24 under 35 U.S.C. § 103(a) should be withdrawn.

Discussion of the Rejection of Dependent Claim 6

The Examiner has also rejected Claim 6 as being unpatentable over Outlook in view of Thompson and further in view of Yahoo (Non Patent Literature, Nov. 9, 2000 and Sept 8, 1999). However, because dependent claims include all of the elements of the independent claim from which the dependent claims ultimately depend, dependent Claim 6 is patentable for at least the reasons

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discussed above in regard to independent Claim 1. Accordingly, the rejection of dependent Claim 6 under 35 U.S.C. § 103(a) should be withdrawn.

Discussion of the Rejection of Dependent Claims 25 and 26

The Examiner has rejected Claims 25-26 as being unpatentable over Thompson in view of Wordworks and further in view of Microsoft Word (Non Patent Literature, copyright 1999 hereinafter known as "MS-Word"). However, Claims 25-26 depend from independent Claim 23, which is patentable for the reasons discussed above. Because dependent claims include all of the elements of the independent claim from which the dependent claims depend, dependent Claims 25-26 are patentable for at least the reasons discussed above in regard to independent Claim 23. Accordingly, the rejection of dependent Claims 25-26 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Dependent Claims 15 and 16

The Examiner has rejected dependent Claims 15 and 16 as being unpatentable over Outlook in view of Gehani and further in view of Wordworks. However, Claims 15 and 16 depend from independent Claim 11, which is patentable for the reasons discussed above. Because dependent claims include all of the elements of the independent claim from which the dependent claims depend, dependent Claims 15-16 are patentable for at least the reasons discussed above in regard to independent Claim 11. Accordingly, the rejection of dependent Claims 15-16 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Dependent Claim 17

The Examiner has rejected dependent Claim 17 in view of Outlook in view of Gehani and in view of MS-Word. However, Claim 17 depends from independent Claim 11, which is patentable for the reasons discussed above. Because dependent claims include all of the elements of the independent claim from which the dependent claims depend, dependent Claim 17 is patentable for at least the reasons discussed above in regard to independent Claim 11. Accordingly, the rejection of dependent Claim 17 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Dependent Claims 20

The Examiner has rejected dependent Claim 20 in view of Outlook in view of Gehani and in view of Thompson. However, Claim 20 depends from independent Claim 11, which is patentable for the reasons discussed above. Because dependent claims include all of the elements of the independent claim from which the dependent claims depend, dependent Claim 20 is patentable for at

least the reasons discussed above in regard to independent Claim 11. Accordingly, the rejection of dependent Claim 20 under 35 U.S.C. § 103(a) should be withdrawn.

In view of the Remarks set forth above, it will be apparent that the claims in this application define a novel and non-obvious invention. The application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

Ronald M. Anderson
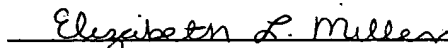Registration No. 28,829

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